

REDACTED VERSION OF DOCUMENT SOUGHT TO BE SEALED

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**UNITED STATES DISTRICT COURT**  
**NORTHERN DISTRICT OF CALIFORNIA**  
**SAN FRANCISCO DIVISION**

THE REGENTS OF THE UNIVERSITY OF  
CALIFORNIA, a California corporation,

Plaintiff,

v.

ROGER JINTEH ARRIGO CHEN, an individual;  
GENIA TECHNOLOGIES, INC., a Delaware  
corporation; and DOES 1-25,

Defendants.

Case No. 3:16-cv-07396-EMC

**DEFENDANTS' NOTICE OF MOTION  
AND MOTION TO JOIN OXFORD  
NANOPORE TECHNOLOGIES, INC.**

Presiding: Hon. Edward M. Chen  
Date: June 21, 2018  
Time: 1:30 PM  
Courtroom: Courtroom 5, 17<sup>th</sup> Floor

**JURY TRIAL DEMANDED**

Case No. 3:16-cv-07396-EMC

**MOTION TO JOIN OXFORD  
NANOPORE TECHNOLOGIES, INC.**

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**NOTICE OF MOTION AND MOTION****TO: PLAINTIFF AND ITS ATTORNEYS OF RECORD**

**PLEASE TAKE NOTICE** that on June 21, 2018 at 1:30 PM, before the Honorable Edward M. Chen, Defendants Roger Chen and Genia Technologies, Inc. (“Genia”) (collectively, “Defendants”) will, and hereby do, move the Court to join Oxford Nanopore Technologies, Inc. (“Oxford”) as a party-plaintiff pursuant to Fed. R. Civ. P. 19(a)(1). This Motion is supported by the following Memorandum of Points and Authorities; the Declaration of Christopher R. Noyes, and exhibits attached thereto; and such other written or oral argument as may be presented at or before the time this motion is taken under submission by the Court.

**STATEMENT OF REQUESTED RELIEF**

Pursuant to Fed. R. Civ. P. 19(a)(1), Defendants request that the Court join Oxford as a party-plaintiff in this action.

**STATEMENT OF ISSUE TO BE DECIDED**

Whether, pursuant to Fed. R. Civ. P. 19(a)(1), Oxford must be joined as a party-plaintiff in this action.

**MEMORANDUM OF POINTS AND AUTHORITIES****I. INTRODUCTION**

For nearly one year, Defendants have pursued discovery on license agreements between The University of California, Santa Cruz (“UCSC”) and Oxford in an effort to understand the relationship between UCSC and Oxford, and Oxford’s role in this litigation. For months, Plaintiff The Regents of the University of California (“UC”) would only produce a heavily redacted version of UCSC’s license agreement with Oxford. Defendants were eventually able to obtain a less redacted version of the license agreement on February 9, 2018. (*See* Decl. Ex. A, “Amended and Restated License Agreement,” Dec. 19, 2016, UCAL-00005105 (the “Amended Agreement”).) The Amended Agreement disclosed that [REDACTED]

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1 [REDACTED]  
2 [REDACTED], which  
3 were ultimately produced by UC on March 2, 2018. (Decl. Ex. B, UCAL-00116273, Ex. C,  
4 UCAL-00116270.)  
5 [REDACTED]  
6 [REDACTED]

7 [REDACTED] Just ten days before  
8 UC filed suit against Defendants, [REDACTED]  
9 [REDACTED]  
10 [REDACTED]  
11 [REDACTED]  
12 [REDACTED]  
13 [REDACTED]  
14 [REDACTED]  
15 [REDACTED]  
16 [REDACTED]  
17 [REDACTED]  
18 [REDACTED]  
19 [REDACTED]  
20 [REDACTED]  
21 [REDACTED]  
22 [REDACTED]  
23 [REDACTED]

24 \_\_\_\_\_  
25 <sup>1</sup> U.S. Patent Application Nos. 14/056,636, 14/300,453, 14/919,315, 15/087,734, and  
26 15/162,225; along with U.S. Patent Application Nos. 60/921,787, 60/931,115, 60/967,539,  
27 12/080,684, and International PCT Application No. PCT/US2008/004467. ECF No. 48, FAC, ¶  
28 32.

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1 [REDACTED]  
2 Additionally, Oxford previously filed its *own* patent applications claiming ownership of certain  
3 of the claims and inventions in dispute here. As such, a determination of ownership in this case  
4 that only resolves the dispute between UC and Defendants “cannot accord complete relief among  
5 existing parties.” Fed. R. Civ. P. 19(a)(1).  
6

7 Given Oxford’s [REDACTED] in the outcome of this dispute, and because  
8 Defendants face a substantial risk of incurring double, multiple, or otherwise inconsistent  
9 obligations because of Oxford’s interests, Oxford is a necessary party in this action under  
10 Federal Rule of Civil Procedure 19(a)(1). Defendants respectfully submit to this Court that  
11 Oxford therefore should be joined as a party-plaintiff.  
12

## 13 II. LEGAL STANDARD

14 Pursuant to Federal Rule of Civil Procedure Rule 19(a)(1), a party that is “subject to  
15 service of process and whose joinder will not deprive the court of subject-matter jurisdiction  
16 must be joined as a party.” A party must be joined under Rule 19(a)(1)(A) if “in that person’s  
17 absence, the court cannot accord complete relief among existing parties.” Alternatively, a party  
18 must be joined under Rule 19(a)(1)(B) if that party “claims an interest relating to the subject of  
19 the action and is so situated that disposing of the action in the person’s absence may: (i) as a  
20 practical matter impair or impede the person’s ability to protect the interest; or (ii) leave an  
21 existing party subject to a substantial risk of incurring double, multiple, or otherwise inconsistent  
22 obligations because of the interest.” If either of the above conditions are met, the Ninth Circuit  
23 deems the party to be “necessary,” using the “the traditional terminology.” *Am. Greyhound*  
24 *Racing, Inc. v. Hull*, 305 F.3d 1015, 1022 (9th Cir. 2002).

25 When “an absentee is a necessary party” then “the second stage is for the court to  
26 determine whether it is feasible to order that the absentee be joined.” *E.E.O.C. v. Peabody W.*  
27 *Coal Co.*, 400 F.3d 774, 779 (9th Cir. 2005). There are “three circumstances in which joinder is

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1 not feasible: when venue is improper, when the absentee is not subject to personal jurisdiction,  
2 and when joinder would destroy subject matter jurisdiction.” *Id.*

3 As demonstrated below, Oxford is a necessary party that must be joined as a plaintiff  
4 under Rule 19(a)(1), and joinder is feasible here.

### 5 **III. FACTUAL BACKGROUND**

#### 6 **A. Plaintiff’s Lawsuit**

7 Plaintiff UC brought this action alleging that defendant Roger Chen, while a graduate  
8 student at the UCSC, “conceived of and developed a series of inventions and proprietary  
9 technologies relating to a computer chip containing an array of individually addressable  
10 nanopores, which is used in characterizing a nucleic acid sequence of each of a plurality of  
11 nucleic acid molecules (the ‘UCSC Inventions’).” (ECF No. 48, First Amended Complaint, ¶ 2.)  
12 UC seeks injunctive relief and damages relating to the alleged UCSC Inventions, including,  
13 among other things, assignment of certain patent rights, disgorgement of profits purportedly  
14 attributable to those rights, and other monetary damages. (*See id.* at 45-46.)  
15

16  
17 Currently, UC is the sole named plaintiff. In its Certificate of Interested Parties, UC  
18 disclosed that Oxford “has a financial interest in the subject matter in controversy as the  
19 exclusive licensee of certain patent applications and patents involved in this dispute.” (ECF No.  
20 4 at 2.) Until recently, however, the extent of Oxford’s interest in this dispute was unknown to  
21 Defendants. After Defendants made repeated requests for Oxford’s exclusive license to the  
22 patent applications and patents involved in this dispute, on February 9, 2018, UC produced a  
23 sufficiently unredacted version of the “Amended and Restated License Agreement” between  
24 Oxford Nanopore Technologies Limited and the Regents of the University of California (the  
25 “Amended Agreement”). [REDACTED]  
26



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**B. The UCSC/Oxford License Agreements**

<sup>2</sup> On April 14, 2017, Defendants served discovery requests seeking any license agreements between UCSC and Oxford. On November 29, 2017, Plaintiff produced a heavily redacted version of the Amended Agreement. The same day, Defendants notified Plaintiff that they intended to take steps to obtain the full agreement. Plaintiff produced the Amended Agreement for a second time on December 5, 2017; once again, it was heavily redacted. On January 3, 2018, Defendants again requested an unredacted copy of the Amended Agreement. On January 12, 2018, Plaintiff again produced a heavily redacted version. On February 6, 2018, Defendants requested an unredacted copy of the Amended Agreement for the third time. On February 9, 2018, Defendants finally received a far less redacted version of the Amended Agreement.

UC also alleges that certain Genia patents are “derived from the UCSC Inventions.” (ECF No. 48 ¶ 5; *id.* ¶ 57 (listing the “Genia Patents”).) According to UC, the Genia Patents “rightfully belong to the University” as the purported “true owner of the Genia Patents.” (ECF No. 48 ¶¶ 6-7.)

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

4 [REDACTED]

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1 [REDACTED]<sup>5</sup>

2 **C. Oxford's Patent Applications**

3 [REDACTED]

4 [REDACTED]

5 [REDACTED], Oxford has filed patent applications and holds its own

6 issued patents relating to DNA sequencing. Two of Oxford's patent applications directly copied

7 claim language from Genia's U.S. Patent No. 8,461,854, which is one of the Genia patents

8 plaintiff UC claims to rightfully own. (Decl. Ex. D, U.S. Patent Application No. 14/302,287, Ex.

9 E, U.S. Patent Application No. 14/302,303.)<sup>6</sup> The Oxford patent applications name different

10 inventors than the University Patent Applications and the Genia Patents. (*Id.*) Oxford's separate

11 claim to ownership of the same technology in dispute in this case is not presently part of this

12 case.

13

14

15 **IV. ARGUMENT**

16 **A. Oxford Is a Necessary Party Under Fed. R. Civ. P. 19(a)(1)**

17 When "conducting the Rule 19(a)(1) analysis," the inquiry is "whether the absence of the

18 party would preclude the district court from fashioning meaningful relief as between the parties."

19 *Cuevas v. Joint Benefit Tr.*, No. 13-CV-00045-JST, 2013 WL 3578496, at \*2 (N.D. Cal. July 12,

20

21 <sup>5</sup> [REDACTED]

22 [REDACTED], UC did not join Oxford as a party to this action. (ECF No. 1, Dec. 29, 2016.)

23 In August and October 2016, the PTO issued Office actions for U.S. Patent Application Nos.

24 14/302,287 and 14/302,303, to which Oxford did not respond. (Decl. Ex. F, Ex. G.)

25 Accordingly, in 2017 the PTO issued notices of abandonment for U.S. Patent Application Nos.

26 14/302,287 and 14/302,303. (Decl. Ex. H, Ex. I.) While U.S. Patent Application Nos.

27 14/302,287 and 14/302,303 were abandoned, Oxford has recently filed new continuation patent

28 applications that would allow Oxford to once again pursue these copied claims. (Decl. Ex. J

(U.S. Patent Application No. 15/434,574, continuation of U.S. Patent Application No.

14/302,287); Ex. K (U.S. Patent Application No. 15/491,450, continuation of U.S. Patent

Application No. 14/302,303).)

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2013) (quotations omitted). “This factor is concerned with consummate rather than partial or hollow relief as to those already parties, and with precluding multiple lawsuits on the same cause of action.” *Id.* The Court’s inquiry is “guided by pragmatic considerations,” including whether a licensee has “a sufficient interest ... as could ... subject [Defendants] to multiple liability.” *Katz v. Lear Siegler, Inc.*, 909 F.2d 1459, 1462 (Fed. Cir. 1990) (quotations omitted); *see also id.* (“joinder of claims, parties and remedies is strongly encouraged”) (quoting *United Mine Workers v. Gibbs*, 383 U.S. 715, 724 (1966)). Notably, the less redacted Amended Agreement was important for Defendants to obtain prior to moving to join Oxford in part because [REDACTED]

**1. Joining Oxford Is Necessary Under Rule 19(a)(1)(A) To Accord Complete Relief to the Existing Parties**

To fashion meaningful relief for the existing parties in this patent ownership dispute, Oxford must be joined. A determination of ownership without Oxford’s participation will result in incomplete relief because (1) [REDACTED]

[REDACTED]; and (3) Oxford has independently filed (without UCSC) patent applications asserting ownership of the same claims at issue here.

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1 [REDACTED]  
2 [REDACTED]  
3 [REDACTED]. *See, e.g.,*  
4 *SonoSim, Inc. v. Medaphor Ltd.*, No. CV 16-2847-GW, 2016 WL 7479363, at \*2-3 (C.D. Cal.  
5 Oct. 17, 2016) (holding that an exclusive licensee had standing to sue despite [REDACTED]  
6 [REDACTED]  
7 [REDACTED]  
8 [REDACTED] To alleviate that threat and to accord complete  
9 relief, Oxford must be joined. *See Superguide Corp. v. DirectTV Enters., Inc.*, 202 F.R.D. 460,  
10 463 (W.D.N.C. 2001) (“The court finds that joinder of [the exclusive licensee] is necessary to  
11 afford complete relief among the parties.”).

12 [REDACTED]  
13 [REDACTED]  
14 [REDACTED]  
15 [REDACTED]  
16 [REDACTED]  
17 [REDACTED] Joining  
18 Oxford in this action will allow complete and meaningful resolution of [REDACTED] ownership  
19 claims arising out of the facts and circumstances that led to this litigation. Oxford’s non-joinder,  
20 on the other hand, “creates a genuine risk of multiple adjudications on the same issues and  
21 creates real doubt that this court’s judgment will accord the parties the relief to which they are  
22 ultimately entitled.” *Gould v. Control Laser Corp.*, 462 F. Supp. 685, 687 (M.D. Fla. 1978),  
23 *aff’d in part and appeal otherwise dismissed*, 650 F.2d 617 (5th Cir. 1981); *see also Cuevas*, No.  
24 13-CV-00045-JST, 2013 WL 3578496, at \*2.

25 In patent cases, “[i]t is well settled that ‘[f]or the same policy reasons that a patentee must  
26 be joined in any lawsuit involving his or her patent, there must be joinder of any exclusive  
27

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licensee.” *IRIS Corp. Berhad v. United States*, 82 Fed. Cl. 488, 499 (Fed. Cl. 2008) (quoting *Aspex Eyewear, Inc. v. Miracle Optics, Inc.*, 434 F.3d 1336, 1344 (Fed. Cir. 2006)). In *Aspex*, the Federal Circuit looked to longtime Supreme Court precedent asserting that “both the owner [of a patent] and the exclusive licensee are generally necessary parties in an action in equity.” 434 F.3d at 1344 (citing *Indept. Wireless Tel. Co. v. Radio Corp. of Am.*, 269 U.S. 459, 466 (1926)). *Aspex* has been widely cited and followed. See, e.g., *Advanced Audio Devices, LLC v. Bay Consumer, Inc.*, No. 10 C 7699, 2011 WL 6016242, at \*3 (N.D. Ill. Dec. 2, 2011) (citing *Aspex* and explaining that “[a]n exclusive licensee should be joined to a suit by the patentee”); *Amgen*, 456 F. Supp. 2d at 283 (“Pursuant to *Aspex*, the Court rules that an exclusive licensee must be joined in an infringement suit brought by the patent owner.”); 1 Annotated Patent Digest § 9:50 (“not only does the exclusive licensee have the right to join a suit brought by the patentee, the Federal Circuit has held that the exclusive licensee must be joined”).

The Federal Circuit’s decision in *Aspex* is persuasive authority here because the “public policy in favor of preventing multiple lawsuits on the same patent against the same accused infringer” extends to the ownership dispute central to this case. 434 F.3d at 1343; see also *Katz*, 909 F.2d at 1462 (where patent holder brought infringement suit, Federal Circuit affirmed joinder of licensee, “agree[ing] with the district court that [determining exactly who owns the patents] is facilitated by joinder”).

Because “the disposition of this suit” could “expose the defendants to multiple lawsuits if [the exclusive licensee] is not joined,” Oxford should be joined as a party-plaintiff. *IRIS*, 82 Fed. Cl. at 499.

Third, Oxford has filed its own patent applications (separate from UCSC) that are implicated here. Some of Oxford’s patent applications copy language from U.S. Patent No. 8,461,854 (“Genia’s ’854 Patent”), one of the Genia Patents at issue in this litigation and to

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1 which UC claims ownership. (Decl. Ex. D, Ex. E.) To illustrate, Claim 1 of Genia's '854 Patent  
2 includes the following claim language:

3 [A] chip comprising a plurality of individually addressable nanopores, an  
4 individually addressable nanopore of said plurality of individually addressable  
5 nanopores containing at least one nanopore formed in a membrane disposed adjacent  
6 to an electrode, wherein each individually addressable nanopore is adapted to  
7 detect a nucleic acid molecule or a portion thereof[.]

8 (Decl. Ex. L.) In this litigation, UC asserts that it is the rightful owner of this claimed invention:

9 . . . Akesson, Deamer, Dunbar, Wilson, and, on information and belief, Chen, jointly  
10 conceived of at least systems for sequencing nucleic acid . . . as claimed in at least the  
11 Genia '854 Patent . . . :

12 (a) a chip comprising a plurality of individually addressable nanopores, an  
13 individually addressable nanopore of said plurality of individually addressable  
14 nanopores containing at least one nanopore formed in a membrane disposed  
15 adjacent to an electrode, wherein each individually addressable nanopore is  
16 adapted to aid in the detection of said nucleic acid molecule or a portion[.]

17 (ECF No. 48 ¶ 83(a).) However, Oxford has separately taken the position in the Patent Office  
18 that it (not UC) is the owner of this claimed invention in its U.S. Patent Application Nos.  
19 14/302,303 and 14/302,287, which read in relevant part:

20 [A] chip comprising a plurality of individually addressable nanopores, an individually  
21 addressable nanopore of said plurality of individually addressable nanopores containing  
22 at least one nanopore formed in a membrane disposed adjacent to an electrode, wherein  
23 each individually addressable nanopore is adapted to detect a nucleic acid molecule or a  
24 portion thereof[.]

25 (Decl. Ex. D, Ex. E.)

26 Clearly, "nearly identical claims raise a substantial inventorship question." *Leviton Mfg.*  
27 *Co. v. Universal Sec. Instruments, Inc.*, 606 F.3d 1353, 1360 (Fed. Cir. 2010). Therefore,  
28 Oxford must necessarily be joined as a party in this case. The Court cannot fully resolve the  
existing parties' ownership dispute because Oxford, as a non-party, has previously claimed that it  
is the rightful owner of the same inventions in dispute here. As such, a determination of

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ownership that only resolves the dispute between Plaintiff UC and the Defendants “cannot accord complete relief among existing parties.” Fed. R. Civ. P. 19(a)(1).

Oxford not only has the means ( [REDACTED] ) to pursue separate litigation against Defendants, Oxford has the incentive (separate from UCSC) to do so as a commercial competitor to Genia in DNA sequencing. Thus, failing to join Oxford could provide Oxford with a second bite at the apple by, for example, [REDACTED] in the event that Defendants prevail against UC. *See Gould*, 462 F. Supp. at 687 (“In the event that the judgment is adverse to [the patentee] ... [the exclusive licensee] might well feel free to relitigate the issue in another forum.”). Where, as here, non-joinder “could subject [a party] to multiple litigation,” then joinder is required in order to provide “complete relief.” *Walsh v. Centeio*, 692 F.2d 1239, 1243-44 (9th Cir. 1982).

## 2. Oxford Is a Necessary Party Under Rule 19(a)(1)(B)

Oxford also must be joined as a party pursuant to Rule 19(a)(1)(B). There is no question that Oxford “claims an interest relating to the subject of the action.” “An exclusive licensee is considered to have” a “legally protected interest in the patent.” *Propat Int’l Corp. v. Rpost, Inc.*, 473 F.3d 1187, 1193 (Fed. Cir. 2007); *see also IRIS*, 82 Fed. Cl. at 499 (granting motion to join exclusive licensee as a party plaintiff; finding “[licensee] retains a significant interest in the patent-in-suit[, based on] ... a long-term exclusive license with a potentially substantial financial stake in the patent-in-suit [and the potential for] ... 30 percent of the proceeds of this litigation”). Accordingly, as the exclusive licensee [REDACTED], Oxford indisputably has an interest in this action. *See supra* III.B. Further, disposing of this action in Oxford’s absence would (1) leave Defendants subject to a substantial risk of incurring multiple or inconsistent obligations [REDACTED], and (2) could impair or impede Oxford’s



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1 ability to protect ownership interests [REDACTED] or its  
2 own patent applications.

3           a.       *If Oxford is not joined, Defendants face substantial risks of*  
4                   *incurring multiple or inconsistent obligations.*

5           “Rule 19 is intended” not only “to protect the absentee from prejudice,” but also “to  
6 protect those made parties from harassment by successive suits, and to protect the courts from  
7 being imposed upon by multiple litigation.” 7 Fed. Prac. & Proc. Civ. § 1609 (3d ed.). [REDACTED]  
8 [REDACTED]  
9 [REDACTED] *Gould*, 462 F. Supp. at 686. “There can  
10 be little question but that, had it elected to do so,” [REDACTED] action  
11 here. *Id.* at 687. Accordingly, “[s]ince [Oxford] is a ‘proper party’ with an [REDACTED]  
12 [REDACTED], an order compelling [its] joinder would  
13 work no unfairness to either” Oxford or Plaintiff. *Id.* That alone is basis enough to join Oxford.  
14 *See id.* (“The considerations of finality, judicial economy and fairness which underpin Rule 19  
15 demand under these circumstances that [the exclusive licensee] be brought into the litigation.”).

16  
17  
18 Further, for the reasons described above, [REDACTED]  
19 [REDACTED]

20 [REDACTED] The absence of Oxford as a party in this case means that  
21 “there can simply be no guarantee that defendants will not be exposed to the risk of multiple  
22 adjudications or that a final, binding judgment deciding all the issues between the parties can be  
23 entered by this court.” *Id.* at 688; *cf. Pit River Home & Agr. Co-op. Ass’n v. United States*, 30  
24 F.3d 1088, 1098-1099 (9th Cir. 1994) (affirming dismissal of, *inter alia*, plaintiff’s ownership  
25 claim based on failure to join tribal council in possession of land, deeming absentee tribal  
26

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1 council a “necessary party to this action” because judgment would not bind the tribal council  
2 from “assert[ing] its right to possess” the property).

3 *b. Not joining Oxford could impair or impede its ability to protect its*  
4 *claimed interest.*

5 This dispute also implicates Oxford’s own rights and alleged ownership in the disputed  
6 inventions; [REDACTED], “the interest [of the party that  
7 Defendants seek to join] arises from terms in bargained contracts, and the interest is substantial.”  
8 *Am. Greyhound Racing*, 305 F.3d at 1023. Plaintiff UC argues that the Genia Patents at issue in  
9 this litigation were “derived from” the “UCSC Inventions,” which purportedly “rightfully belong  
10 to the University.” (ECF No. 48 ¶¶ 5-6.) At the same time, UC claims that its own “University  
11 Patent Applications” are also “based on the UCSC Inventions.” (*Id.* ¶ 3.) If Defendants prevail  
12 here, that will implicate the purported UCSC Inventions and, by extension, [REDACTED]  
13 [REDACTED]. *See IRIS*, 82 Fed. Cl. at 499 (“[T]he  
14 disposition of [licensor’s] suit without [the exclusive licensee] could impair or impede [the  
15 exclusive licensee’s] ability to protect his interests.”); *cf. Pit River Home*, 30 F.3d at 1098-1099  
16 (tribal council, as possessor of disputed property, had “a legal interest in the litigation, which  
17 would be impaired by the disposition of th[e] action without [the tribal council’s] presence”).  
18 Therefore, “[a]djudication of plaintiff’s claim necessarily will adjudicate the [absent party’s]  
19 right to enforce the contract it has negotiated”—a practical reality that supports joinder. *See*  
20 *Greer v. Pac. Gas & Elec. Co.*, No. 1:15-CV-01066-EPG, 2016 WL 2939148, at \*3 (E.D. Cal.  
21 May 18, 2016).

22 Finally, as discussed above, the fact that both UCSC and Oxford have purported to be the  
23 inventors of the same disputed claims means that any adjudication here implicates (without  
24  
25  
26  
27  
28

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1 resolving) Oxford’s interests. Oxford’s “participation is necessary to protect its legally  
2 cognizable interests [and] to protect other parties from a substantial risk of incurring multiple or  
3 inconsistent obligations because of those interests.” *Cuevas*, No. 13-CV-00045-JST, 2013 WL  
4 3578496, at \*2 (quotation omitted). As a result, Oxford should be joined.

5 **B. Joining Oxford Is Feasible**

6 It is feasible to join Oxford as a party in this action. This Court has subject-matter  
7 jurisdiction unaffected by joinder of Oxford, venue is proper, and, as set forth below, Oxford is  
8 unquestionably subject to personal jurisdiction.

9 **1. Oxford Is Subject to Personal Jurisdiction in This Forum**

10 Oxford is a corporation organized under the laws of Delaware and has its principal place  
11 of business located at 1 Kendall Square, Cambridge, MA 02139. *Illumina, Inc. et al v. Oxford*  
12 *Nanopore Technologies Ltd. et al*, 3:16-cv-00477 (S.D. Cal.), ECF No. 14 at 2 (“Consent Order,  
13 Final Judgment, and Permanent Injunction”). “In deciding whether the Court has jurisdiction  
14 over an out-of-state defendant, the Court looks to Federal Circuit precedent,” which uses the  
15 same test as the Ninth Circuit “when applying the minimum contacts standard set forth by the  
16 Supreme Court.” *Wistron Corp. v. Phillip M. Adams & Assocs., LLC*, No. C-10-4458 EMC,  
17 2011 WL 1654466, at \*3 (N.D. Cal. Apr. 28, 2011). “Because California’s long-arm  
18 jurisdictional statute is coextensive with the limits of due process, the two inquiries  
19 [constitutional and statutory] collapse into a single inquiry: whether jurisdiction comports with  
20 due process.” *Id.* (quoting *Inamed Corp. v. Kuzmak*, 249 F.3d 1356, 1360 (Fed. Cir. 2001)).  
21 “The Court considers three factors in determining whether the exercise of specific personal  
22 jurisdiction over an out-of-state defendant comports with due process: (1) whether the defendant  
23 ‘purposefully directed’ its activities at residents of the forum; (2) whether the claim ‘arises out of  
24 or relates to’ the defendant’s activities in the forum; and (3) whether the exercise of jurisdiction  
25 is ‘reasonable and fair.’” *Id.* at \*4 (quoting *Deprenyl Animal Health, Inc. v. Univ. of Toronto*  
26 *Innovations Found.*, 297 F.3d 1343, 1351 (Fed. Cir. 2002)).

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1                   **2. Oxford Has Purposefully Directed Relevant Activities to Residents in**  
2                   **This Forum**

3                   While discovery is ongoing,<sup>7</sup> it is undisputed that Oxford holds an exclusive license  
4 agreement with UCSC, a California institution. (ECF No. 4 at 2.) [REDACTED]

5 [REDACTED]  
6 [REDACTED]  
7 [REDACTED]  
8 [REDACTED]  
9 [REDACTED]  
10 [REDACTED]  
11 [REDACTED]  
12 [REDACTED]  
13 [REDACTED]  
14 [REDACTED]  
15 [REDACTED]  
16 [REDACTED]

17                   **3. UC's Claims Relate to Oxford's Contacts with California**

18 [REDACTED]  
19 [REDACTED]  
20 [REDACTED]  
21 [REDACTED]  
22 [REDACTED]  
23 [REDACTED]

24 <sup>7</sup> Defendants' pending discovery requests include, *inter alia*, [REDACTED]  
25 [REDACTED]; (2) communications between Oxford and the  
26 alleged UCSC Inventors concerning Defendants; and (3) [REDACTED]  
27 [REDACTED].

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[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] There is no question that Oxford

has been [REDACTED]

[REDACTED] and other activities in this forum. Moreover, if UC were to prevail on its claim for

damages, [REDACTED]

[REDACTED]

#### 4. The Exercise of Personal Jurisdiction is Reasonable and Fair

Oxford has directed relevant commercial activities at residents of California and has engaged in negotiations and litigation with the California-based parties to this suit. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] Considering Oxford's

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1 “extensive licensing and enforcement activities with California residents, it would not be unfair  
 2 to require [it] to litigate in this Court.” See *Wistron*, No. C-10-4458 EMC, 2011 WL 1654466, at  
 3 \*10. Moreover, Oxford previously waived service of a complaint in a patent infringement action  
 4 brought against Oxford in the Southern District of California. *Illumina, Inc. et al v. Oxford*  
 5 *Nanopore Technologies Ltd. et al*, 3:16-cv-00477 (S.D. Cal.), ECF No. 8 at 1. Oxford consented  
 6 to jurisdiction in that case, and the district court found that it had personal jurisdiction over  
 7 Oxford, and that venue was proper. *Id.* at ECF No. 14 at 1-2.

8 Finally, as a practical matter, discovery is ongoing in this matter and Oxford is already  
 9 involved, such that Oxford’s joinder should not delay the trial date set in this matter.<sup>8</sup> Oxford  
 10 made initial document productions on March 9 and March 26, 2018, in response to a Rule 45  
 11 subpoena.<sup>9</sup> While Oxford has produced some documents, third-party discovery of Oxford is  
 12 insufficient and ultimately prejudicial to Defendants. For example, Oxford has repeatedly  
 13 objected to identifying and producing documents that are “in the possession of Plaintiff[]” while  
 14 at the same time Plaintiff has repeatedly objected to producing documents “that may be subject  
 15 to third party confidentiality obligations or restrictions.” (Decl. Ex. O, Oxford’s Responses &  
 16 Objections to Genia’s Subpoena, Response to Request Nos. 1, 8, 14, 15; Decl. Ex. P, Plaintiff’s  
 17 Responses to Defendants’ First Set of Production Requests, Nos. 11, 25, 27, 28, 43, 53.) On  
 18 March 9, 2018, Plaintiff also added various search terms involving Oxford to the list Defendants  
 19 will apply to their collection of email electronically stored information (“ESI”), indicating  
 20 Plaintiff’s acknowledgment of the importance of Oxford to this litigation. And, as described  
 21  
 22

23 <sup>8</sup> Separately, the Court has granted the parties’ joint stipulation to extend fact discovery in this  
 24 litigation. ECF No. 85.

25 <sup>9</sup> [REDACTED]  
 26 [REDACTED]  
 27 [REDACTED] These documents are relevant to Defendants’  
 28 statutes of limitations defense. ECF Nos. 73 at 17 and 74 at 17.

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1 above, UC and Oxford share the same outside counsel. Oxford's joinder would not represent a  
2 hardship for the existing parties.

3 **V. CONCLUSION**

4 For the foregoing reasons, Defendants respectfully request that the Court join Oxford as a  
5 party-plaintiff in this action.

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Dated: April 6, 2018.

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**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on April 6, 2018, to all counsel of record who are deemed to have consented to electronic service via the Court's CM/ECF system per Civil Local Rule 5.5. Any other counsel of record will be served by electronic mail, facsimile, and/or overnight delivery.

/s/ Robert J. Gunther, Jr.